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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STEPHEN B. BAILEY and
MICHAEL C. SCHONEBERGER

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Appeal 2016-001632
Application 13/196,036
Technology Center 1700

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Before TERRY J. OWENS, MARK NAGUMO, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1 and 3–21. We have jurisdiction under 35 U.S.C. § 6(b).

*The Invention*

The Appellants claim a wood-based composite panel. Claim 1 is illustrative:

> 1. A wood-based composite panel, comprising:
>
> a top surface having a top perimeter including a first set and a second set of opposing sides;
>
> a bottom surface, opposite the top surface, having a bottom perimeter including a first set and a second set of

opposing sides, the first set and the second set of opposing sides of the bottom surface corresponding in relative positioning to the first set and the second set of opposing sides of the top surface; and

a first and second set of parallel opposing side surfaces, the side surfaces having a first set and second set of opposing sides, the distance between the first set of opposing sides of the side surfaces corresponding to the distance between the first or second set of opposing sides of the bottom surface;

wherein the distance between at least one of the first set or the second of opposing sides of the top surface is about 1/8 inch to about 4 inch less than the distance between the corresponding first set or second set of opposing sides of the bottom surface, and the distance between the second set of opposing sides of at least two opposing side surfaces is between about 1/1000 inch to about 4/10 inch less than an average distance between the top and bottom surfaces, such that the top surface is not susceptible to edge swell,

wherein the distance between the second set of opposing sides of at least the first or second set of opposing side surfaces is less than an average distance between the top and bottom surfaces,

wherein the wood-based composite panel is an oriented strand board (OSB) panel.

*The References*

| | | |
|---|---|---|
| Hanson | US 5,113,632 | May 19, 1992 |
| Crowley | US 5,640,812 | June 24, 1997 |
| Ou | US 6,675,544 B1 | Jan. 13, 2004 |

*The Rejection*

Claims 1 and 3–21 stand rejected under 35 U.S.C. § 103 over Ou in view of Hanson and Crowley.

OPINION

We reverse the rejection. We need address only the independent claims (1 and 21).

Ou discloses "a composite wood panel comprising a first and second longitudinal edge, wherein the first edge includes a groove [17] and the second edge includes a tongue [24], for interlocking and engaging the complementary edges of adjacent tongue and groove wood panels" (col. 1, ll. 48–53). The second longitudinal edge has a shoulder (32) at its junction with a side wall of the tongue such that upon assembly of two complementary wood panels to form a tongue-and-groove joint, the shoulder abuts against the first longitudinal edge, thereby preventing the tongue from being completely inserted into the groove, resulting in spaces (20, 22) (which Oh calls apertures) existing between the first and second longitudinal edges and between the tongue's head and the groove's base (col. 1, ll. 59–67; Fig. 2). The spaces permit the wood panels to expand and swell without undesired stress along their longitudinal edges when the panels absorb moisture, thereby reducing or eliminating panel buckling, bowing, popping and squeaking (col. 2, ll. 1–17). "[T]he preferred wood composites are oriented strand board" (col. 4, l. 39).

Hanson discloses uniform length solid wood planks made from random length boards joined end to end, wherein each board has at each of its four edges a bevel (16) which accentuates the location of the joint between the boards, thereby providing an appearance which is virtually indistinguishable from the appearance of random length solid wood planks, minimizing plank assembly and packing labor costs and reducing raw

material waste and panel installation time (col. 3, ll. 15–34; col. 6, ll. 27–45; Fig. 3).

Crowley discloses a "roof assembly including a triangular ridge beam [50] which is supported by the internal and/or external walls of a structure, and, which in turn supports a plurality of roof panels [10] secured to the ridge beam" (col. 3, ll. 45–49; Fig. 4A). Each roof panel comprises an oriented strand board top sheet (12) and bottom sheet (14) (col. 3, ll. 62–63; col. 4, ll. 5–6). Typically the length of bottom sheet is less than that of the top sheet such that the panel has a beveled end (34) which is "cut at an angle which depends on the style of the roof, the pitch of the roof and the particular location of the panel in the overall roof assembly" (col. 4, ll. 12–14; col. 5, ll. 29–32; Figs. 1B, 3B).

The Examiner finds that Crowley's top and bottom sheets (12, 14) have a beveled edge (Ans. 10).

Crowley does not disclose that the ends of the top and bottom sheets are beveled but, rather, discloses that the top sheet is shorter than the bottom sheet such that an end (10A) of the roof panel is beveled (col. 4, ll. 12–14; Fig. 3B).

The Examiner finds that "aesthetics is not the only reason for beveling as it can ease installation as per the disclosure of Hanson (Abstract) which can readily help relieve edge swelling" (Ans. 10) and that "the Hanson reference specifically discloses that beveling of wooden planks results in ease of installation and accentuates the joining between two wooden planks (Abstract)" (Ans. 8). The Examiner concludes that "it would have been obvious to one of ordinary skill in the art to take advantage of beveling for

the ease of installment and to accentuate the joining so as to prevent unsightly edge swelling" (*id.*).

Hanson's ease of installation is due to the use uniform, standardized length planks formed from random length boards, not due to the boards' edge bevel, the purpose of which is to accentuate the joint between individual boards (col. 3, ll. 16–25). The Examiner does not establish that Hanson's disclosure that beveling board edges accentuates the location of the joint between individual boards of a plank to provide an appearance virtually indistinguishable from the appearance of individual random length solid wood planks (col. 3, ll. 21–30) would have provided one of ordinary skill in the art with an apparent reason to bevel the edges of Ou's boards which, Ou indicates, are used for subflooring which typically is covered by carpet, tile or hardwood such that it no longer is visible (col. 1, ll. 15–28). *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (establishing a prima facie case of obviousness requires an apparent reason to modify the prior art as proposed by the examiner). Nor does the Examiner establish that Hanson would have indicated to one of ordinary skill in the art that the edge bevel prevents edge swelling.

The Examiner finds that "[a]s the better the 'fit' or joining during installation is, the more it would seemingly result in inhibiting edge swelling to occur due to lack of a proper install/fit" (Ans. 10).

That finding, which appears to be inconsistent with Ou's indication that a tongue and groove fit which lacks Ou's apertures (20, 22) results in edge swelling upon moisture absorption (col. 1, ll. 30–39; col. 3, ll. 43–46), is not well taken due to being unsupported by evidence.

Thus, the Examiner has not set forth a factual basis which is sufficient to support a prima facie case of obviousness of the Appellants' claimed invention. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) ("A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art"). Accordingly, we reverse the rejection.

DECISION/ORDER

The rejection of claims 1 and 3–21 under 35 U.S.C. § 103 over Ou in view of Hanson and Crowley is reversed.

It is ordered that the Examiner's decision is reversed.

REVERSED